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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,063

10/15/2003

Gene P. DiPoto

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EXAMINER

BUI, VY Q

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

05/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,063	Applicant(s) DIPOTO ET AL.	
	Examiner Vy Q. Bui	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/12/07;9/13/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-74, 76-110 are rejected under 35 U.S.C. 102(b) as being anticipated by Kogasaka et al.-EP0807415A2.

As to claims 56-74, 76-106, Kogasaka-'415 (line 33, col. 69 to line 48, col. 70; Figs. 110-112, for example) discloses retractor 401, a trocar as a dilator for an introduction of retractor 401 into a spinal location of a patient, at least five discrete segments 444 radially expanding in a non-linear manner, hollow tube 447 to receive a combination of a feed/suction tube and forceps and inherently a process including steps substantially as recited in the claims.

Notice that the recitations "notches" in the claims 87-98 are interpreted as different steps or degrees of expanding of discrete segments 444, which are controlled by how far the rod/tube 447 is pulled proximally.

Further, the recitations "first blade", "second blade" and "first connector"/"second connector" in claims 107-110 are interpreted as segments 444 and mesh 443.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kogasaka et al.-EP0807415A2.

As to claims 75, Kogasaka-'415 discloses substantially the claimed invention, except for explicitly using dilators/trocars to dilate a tissue. However, it is common sense to have trocars of different size for a choice of use and it would have been obvious to one of ordinary skill in the art to provide a physician more than one trocar for dilating and create smaller or larger passages as the physician sees fit.

For example, Foley et al-6,575,899 (col. 12, lines 24-38) discloses dilators of increasing sizes for sequentially dilation of a soft tissue.

Response to Arguments

Applicant's arguments filed 9/7/2007 have been fully considered but they are not persuasive.

1. Argument: Kogasaka-'415A does not appear to disclose or suggest a step of "moving a plurality of discrete segments of the retractor away from each other to retract tissue adjacent the spinal location" as recited in each of the independent claims 56, 65, 74, 87 and 99.

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Response: it is undeniable that Kogasaka-'415's elastic member 444 made of a spring material are expanded from a configuration shown in Fig. 111A to an enlarged configuration shown in Fig. 111B. When elastic members 444 are expanded to strip tissue, members 444 and mesh 443 must apply a pressure on the tissue and therefore retract/move tissue away from the original position of the tissue. Inherently, there must be a step of retracting/moving the tissue away from the original position of the tissue.

2. Argument: Independent claim 65 further recites, "pivoting the distal portion relative to the proximal portion." Kogasaka et al. do not appear to teach or suggest this.

Response: an enlarged configuration in Fig. 111B shows distal portion spring members 444 pivoting about proximal portion located at ring 445.

3. Argument: Independent claim 87 further recites, in part, "wherein the discrete segments are moved away from each other by being guided incrementally along successive notches of a guiding mechanism." Claim 96 recites, "wherein each of said notches maintains a desired configuration of said retractor," claim 97 recites, "wherein each of said notches prevents the retractor from moving from an expanded configuration to a contracted configuration," and claim 98 recites, wherein the guiding mechanism comprises at least three notches." Kogasaka et al. do not appear to teach or suggest these. The Examiner asserts that "notches" are interpreted as different steps or degrees of expanding of discrete segments 444. Applicants respectfully disagree. Kogasaka et al. do not appear to teach or suggest notches or a guiding mechanism, other than the tube 447, which does not appear to have notches or any other structure that would be expected to allow the segments 444 to move away from each other incrementally. The Examiner has not provided any reasoning for the interpretation of "notches of a guiding mechanism" on the structure of Kogasaka et al. Further, the Examiner has not provided any reasoning for why one of ordinary skill in the art would interpret the method steps

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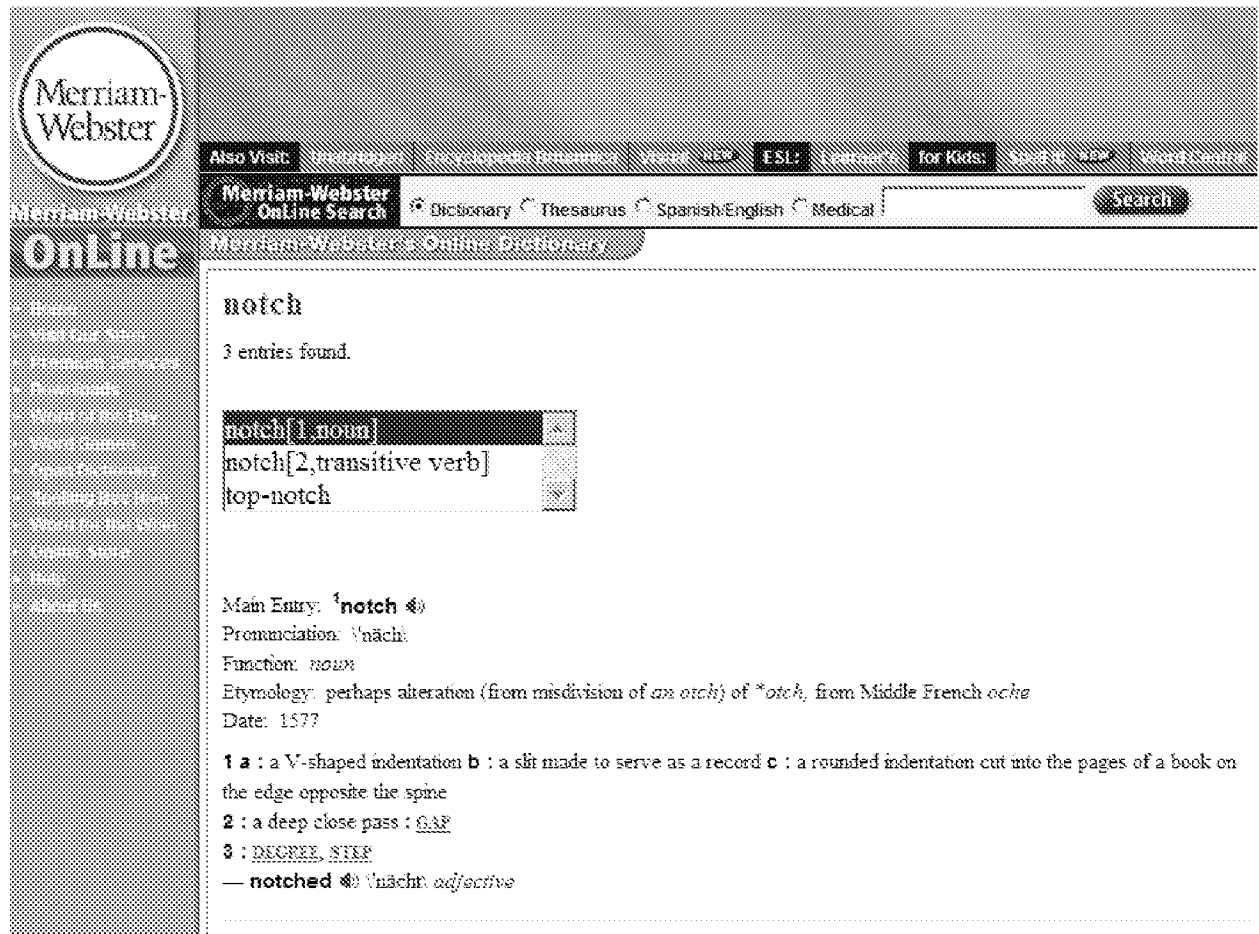
of Kogasaka et al. as including the claimed method step. Kogasaka et al. thus do not appear to teach the identical method steps in the same detail as is recited in claims 87 and 96-98.

Response: a notch, by definition, can be broadly understood as a step, a degree (see definition 3 of “notch” copied and shown on next page, Merriam-Webster Dictionary). Spring member 444 and mesh 443 expand step by step when handling rod 447 is pulled proximally. Each “pulling step” defines a notch as recited in the claims.

4. Argument: Independent claim 107, in part, recites: expanding the retractor by separating a first retractor blade from a second retractor blade by moving at least one of the first retractor blade and the second retractor blade along a first connector of the retractor, and separating a third retractor blade from a fourth retractor blade by moving at least one of the third retractor blade and the fourth retractor blade along a second connector; Kogasaka et al. do not appear to teach or suggest these limitations. In particular, the segments 444 of the elastic member appear to expand away from each other as the rod 447 is withdrawn, but Kogasaka et al. do not appear to teach or suggest moving any of the segments 444 along a connector, as is recited in the claim.

Response: Fig. 111A shows a clearance between mesh/1st connector/2nd connector 443 and spring member 444. Fig. 111B shows a reduced clearance between mesh/1st connector/2nd connector 443 and spring member 444. Inherently, there must be a relative moving between mesh/1st connector/2nd connector 443 and spring member 444 during expanding motion of pring member 444.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vy Q. Bui/

Primary Examiner, Art Unit 3773